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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,517	08/17/2000	Mitsuru Tanabe	KOIK-Q9495	8570

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,517

Applicant(s)

TANABE ET AL.

Examiner

Bradley Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8,10-13,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8,10-13,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 2-8, 10-13, 15 and 16 are presented for examination on the merits.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 October 2004 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 2-8, 10-13, 15 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-8, 10-13, 15 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the

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"progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. Mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In addition, for a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, applicant's recited claims fail to indicate the use of a computer processing system/method wherein the positive recitation in the claims as a whole breathe life and meaning to achieve the stated claimed invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 15, the claim refers to "claim 1" which was previously canceled by the applicant. Therefore, claim 15 fails to further limit a previously broader claim.

As per claim 16, the claim refers to a "method according to claim 3," however, independent claim 3 refers to a computer-readable program; thus claim 16 failing to further limit the scope of claim 3.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-8, 10-13, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Sugiyama, U.S. Patent 5,912,969.

As per the following claims, Sugiyama discloses:

Claims 2, 3 (Currently Amended): An information processing method/computer-readable program comprising: a storage step for storing information for discriminating contents duplicated in the past and temporal data as to a previous start time of duplication of said contents is-tile past into a database; an acquisition step for acquiring the information for discriminating content to be duplicated; a decision step for deciding whether or not copying of the contents discriminated by the discriminating information is allowed in accordance with a comparison between the temporal data stored in the database and current time; and a duplication step for duplicating the contents in accordance with said decision whether copying of the content is allowed or not, wherein the duplication of the content is prohibited when an interval of time between the current time and the previous start time of duplication of said content specified by the temporal data stored in the

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database is less than predetermined amount of time (column 19, line 26-column 23, line 17 and associated figures).

Claim 4 (Currently Amended): The information processing method according to claim 2 wherein said contents is reproduced from an information storage medium (figures 18-21 and associated text).

Claim 5 (Currently Amended): The information processing method according to claim 4 wherein said information recording medium is a compact disc (column 19, lines 42-45).

Claim 10 (Currently Amended): The information processing method according to claim 2, further comprising: a step of checking data in said database; said checking step detecting possible modification using a hash function (column 16, lines 24-57).

Claim 11 (Currently Amended): The information processing method according to claim 2 wherein said predetermined amount of time is a fixed value (column figures 18, 19 and associated text).

Claim 12 (Previously Presented): The information processing method according to claim 2 wherein duplication of the content is allowed when said discrimination information and temporal data of the content to be duplicated is not stored in the database (columns 20-21).

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Claim 15 (New): The information processing method according to claim 1, further comprising: updating the previous start time of duplication in the database to the present time when the duplication of content is permitted (column 10, line 43-column 11, line 64).

Claim 16 (New): The information processing method according to claim 3, further comprising: updating the previous start time of duplication in the database to the present time when the duplication of content is permitted (figure 17 and associated text).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama.

As per claims 6-8, Sugiyama discloses a method of acquiring, storing and duplicating content based on specified and predetermined criteria, i.e., time. Sugiyama does not expressly disclose the use of specific discriminating criteria such as the ISRC unique identifiers or table of contents of artistic works encoded into media in order to carry out the specified step or function.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The step or functions of the claimed invention will be performed regardless of the type of data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*,

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703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize encoded content identifying a work or the specific parts of a work for which such tag are specifically provided for (i.e., ISRC unique identifiers, TOC), because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 13, Sugiyama discloses a method of acquiring, storing and duplicating content based on specified and predetermined criteria, i.e., time. Sugiyama does not expressly disclose the use of a watermarking technique to encrypt data. However, applicant's utilization of a well-known encryption mechanism to embed data in the recording medium does not render the claim otherwise patentable.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

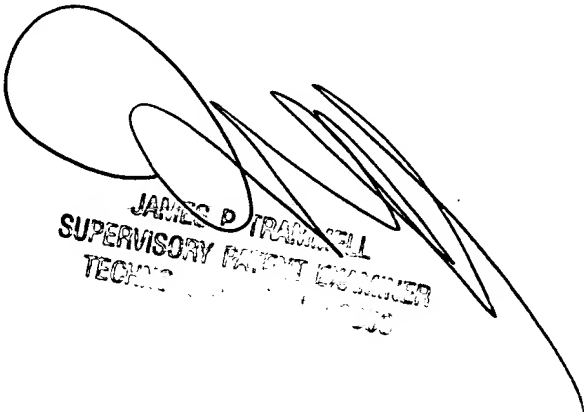
- US Patent 6,034,832 to Ichimura et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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